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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q65849

Shigeharu USHIWATA, et al.

Appln. No.: 09/930,442

Group Art Unit: 3724

Confirmation No.: 2523

Examiner: Omar Flores-Sanchez

Filed: August 16, 2001

For: CUTTER WITH LASER GENERATOR THAT IRRADIATES CUTTING POSITION ON WORKPIECE TO FACILITATE ALIGNMENT OF BLADE WITH CUTTING POSITION

**PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181**

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit that the final Office Action dated March 28, 2006, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner sets forth at least one new ground of rejection which was not necessitated by Applicants' amendments, nor by any new art cited in an Information Disclosure Statement for which a fee was paid. Namely, in an Amendment filed by Applicants on September 21, 2005, Applicants Amended the claims to take subject matter indicated as being allowable by the Examiner in the Office Action as mailed on June 30, 2005. On March 28, 2006, the Examiner made new rejections of the claims based on US Patent 3,787,693 to Stone, which reference is not even of record in the present application.

Despite the above, the Examiner issued a Final Office Action, dated March 28, 2006, in which he propounded the new rejections against the claims, using the newly applied Stone

reference that is still not of record in the present application. And Applicants' amendments have not necessitated this new ground of rejection.

On page 6 of the March 28 Final Office Action, the Examiner attempts to justify the finality of the Office Action by asserting that the new grounds of rejection were based on a reference (namely the Stone reference) that "came to the Examiner's attention via an IDS submitted by applicant in child application (11/357,097), after the first Office Action in the instant application." However, there are two problems with this rationale.

First, Stone has not been made of record in the present application. Further, no fee was paid in connection with the IDS in child application 11/357,097.

Second, the Examiner impermissibly attempts to shift the burden for citing Stone to the Applicants by asserting that it was cited by Applicants in child application 11/357,097 after the first Office Action in the present application. However, **Stone was first cited by Examiner Flores-Sanchez** in another child Application No. 10/902,070, on April 7, 2006, well after the first Office Action mailed on June 30, 2005 in the present application. It was only after Examiner Flores-Sanchez brought Stone to Applicants' attention that they cited it in child application 11/357,097 for sake of completeness.

If the Examiner is allowed to make this Office Action final, it will unjustly deprive Applicants of at least one chance to respond—without the burden of the requirements Under 37 C.F.R. § 1.116—to the new rejections based on art first found and applied (without being citing in the present application) by the Examiner. Applicants submit it is reprehensible that the Examiner attempts to unilaterally strip them of the right to respond Under 37 C.F.R. § 1.111 to a new ground of rejection entirely brought on by the Examiner.

In a telephone conversation with Examiner Flores-Sanchez, conducted on April 5, 2006, Applicants' representative requested that the Examiner reconsider and withdraw the finality of the outstanding Office Action. The Examiner denied Applicants' request and maintains the finality of the Office Action. In response, Applicants submit this petition.

For the reasons discussed above, Applicants request that the finality of the Office Action be withdrawn and that the period for response to the March 28 Office Action be reset. Moreover,

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Applicants submit that such egregious action should not be tolerated by the US Patent Office, and that steps should be taken to prevent any future such attempt to circumvent the rules.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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23373
CUSTOMER NUMBER

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